



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,066	12/15/2000	John M. Nuss	1647.002	1181

7590 10/30/2003

David P. Lentini
Chiron Corporation
4560 Horton Street
Emeryville, CA 94608-2916

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 10/30/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,066

Applicant(s)

NUSS ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-35 and 40-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 6-35, and 40-74 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 7, 9, 13-18, 28-31, 34, 41, 43, 45-52, 55-57, 60-63, and 69-74 drawn to compounds of formula I having the following substituents:

A₁ and A₂ (independently) are aryl, aryloxy, or arylamino;

R₁-R₉ do **not** contain a heteroaryl group (e.g., heteroarylcarbonyl, heteraralkylcarbonyl, or heteroaryl, etc.);

Also, pharmaceutical composition thereof, and method of inhibit GSK-3, and treatment of GSK-3 related disorders.

classified in classes 514, 544, various subclasses depending on substituents.

- II. Claims 1, 7, 9, 13, 19-27, 29, 31, 33, 35, 41, 43, 45-47, 53, 54, 58, 59, 67, 68-74, drawn to compounds of formula I having the following substituents:

A₁ and A₂ (independently) are aryl, aryloxy, or arylamino;

R₁-R₉ (independently) contain a heteroaryl group (e.g., heteroarylcarbonyl, heteraralkylcarbonyl, or heteroaryl, etc.),

Also, pharmaceutical composition thereof, and method of inhibit GSK-3, and treatment of GSK-3 related disorders.

classified in classes 514, 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

Art Unit: 1624

III. Claims 1, 6, 8, 10-12, 35, 40, 42, 44-46, and, 69-74, drawn to compounds of formula I having the following substituents:

A₁ and A₂ (independently) are heteroaryl;

R₁-R₉ (independently) do **not** contain a heteroaryl group (e.g., heteroarylcarbonyl, heteraralkylcarbonyl, or heteroaryl, etc.),

Also, pharmaceutical composition thereof, and method of inhibit GSK-3, and treatment of GSK-3 related disorders.

classified in classes 514, 544, various subclasses depending on substituents.

IV. Claims 1, 6, 8, 10-12, 35, 40, 42, 44-46, and, 69-74, drawn to compounds of formula I having the following substituents:

A₁ and A₂ (independently) are heteroaryl;

R₁-R₉ (independently) contain a heteroaryl group (e.g., heteroarylcarbonyl, heteraralkylcarbonyl, or heteroaryl, etc.),

Also, pharmaceutical composition thereof, and method of inhibit GSK-3, and treatment of GSK-3 related disorders.

classified in classes 514, 544, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation,

different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated for the following reasons:

Compounds in Groups I-IV are drawn to a different combination of ring systems. Although the four groups share the same core of *(5,6,7,8-tetrahydropyridino[4,3-d]pyrimidin-2-yl)-aminoethyl-amine*, said core alone does not sufficiently differentiate the four groups. Thus, it is the combination of R₁-R₉, A₁, and A₂ that gives distinct physical and chemical properties to compounds of each group. A reference that anticipated one group would not do so to the other groups. Thus, the compounds in each group are patentably distinct over those of the other groups, and pose a burden of searching as a separate search is required.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Dennis Shelton on 10-29-03 to request an oral election to the above restriction requirement, a written restriction is preferred.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1624

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (7 am -12 pm, and 3 pm - 6 pm) starting from 10-1st-03.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

October 29, 2003


ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600